



07 JAN 2009

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INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
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WASHINGTON, DC 20006-1109

In re Application of SERVANT et al	:	
U.S. Application No.: 10/563,758	:	
PCT Application No.: PCT/US2004/021853	:	
Int. Filing Date: 09 July 2004	:	DECISION
Priority Date Claimed: 10 July 2003	:	
Attorney Docket No.: 54315US	:	
For: IMPROVED ELECTROPHYSIOLOGICAL	:	
ASSAYS	:	

This is in response to applicant's "Request for Reconsideration of Petition Decision Regarding Renewed Petition" filed 27 October 2008, which is being treated as renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.497(d).

### **BACKGROUND**

On 09 July 2004, applicant filed international application PCT/US2004/021853, which claimed priority of an earlier United States application filed 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 January 2006.

On 09 January 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 07 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 09 July 2007, applicant filed an executed declaration.

On 24 September 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that inventive entity listed on the declaration filed 09 July 2007 differs from that listed on the international application.

On 08 October 2007, applicant filed a response to the Notification of Defective Response.

On 06 February 2008, this Office mailed a communication which indicated that the 08 October 2007 response did not fully remedy the deficiency noted in the Notification of Defective Response and that the present application is accordingly abandoned.

On 06 March 2008, applicant filed the present petitions under 37 CFR 1.137(b), 37 CFR 1.47(a), and 37 CFR 1.497(d).

On 25 June 2008, this Office mailed a decision dismissing the 06 March 2008 petitions.

On 27 October 2008, applicant filed the present renewed petitions under 73 CFR 1.137(b) and 37 CFR 1.497(d).

## **DISCUSSION**

### **I. Petition Under 37 CFR 1.137(b)**

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

### **II. Petition Under 37 CFR 1.497(d)**

The petition states that the sixth inventor was inadvertently omitted from the international application.

MPEP 1893.01(e) states in relevant part,

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application,

which includes any changes effected under PCT Rule 92bis. See 37 CFR 1.41(a)(4). Accordingly, an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied. These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

Petitioner has previously provided items (A) and (B) above. With regard to item (C), the renewed petition states that although a related application was assigned by at least one of the original named inventors, an assignment referencing the present application was not executed by any of the original named inventors.

### CONCLUSION

For the reasons set forth in §I above, the renewed petition under 37 CFR 1.137(b) is GRANTED.

For the reasons set forth in §II above, the renewed petition under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 09 July 2004 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 06 March 2008.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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